

ATTORNEY DOCKET NO. 2006579-0155 (CTX-071)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant:	Yang <i>et al.</i>	Examiner:	Nguyen, D.
Serial No.:	09/866,375	Art Unit:	2154
Filed:	May 25, 2001		
For:	REMOTE CONTROL OF A CLIENT'S OFF-SCREEN SURFACE		

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Appellants offer the present comments in Response to the remarks that were made in the Examiner's Answer mailed August 13, 2007 (the "Answer"). It appears that the Examiner has presented a new ground of rejection in the Answer, but did not designate the rejection as such. That new ground of rejection is focused on Appellants' reliance on the preamble of the claims to provide a patentable distinction over the prior art of record. Appellants choose not to petition under 37 CFR 1.181(a) to have the rejection designated as a new ground of rejection. Appellants choose to address the new grounds of rejection in this Reply Brief and to maintain the Appeal.

The deadline for filing a Reply Brief is October 13, 2007, which is a Saturday. Appellants thus submit that the present Reply Brief is timely filed up to and including October 15, 2007, which is the following Monday.

STATUS OF CLAIMS

No amendments have been made since the Appeal Brief was filed. A listing of pending claims 1-20 was provided in a **Claims Appendix** to the Appeal Brief and still applies.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be reviewed on appeal are now:

- (1) **NEW** – Whether claims 1-20 are limited by their preamble;
- (2) Whether claims 1, 2, 4-9, 12, and 14-18 are obvious over United States Patent No. 6,073,192 to Clapp et al. (“Clapp”) in view of United States Patent No. 6,483,515 to Hanco (“Hanco”) when the combination of Clapp and Hanco fails to teach each and every element of the claimed invention and is improper because any such hypothetical combination would change the principle of operation of the references; and,
- (3) Whether claims 3, 10, 11, 13, 19, and 20 are obvious over United States Patent No. 6,073,192 to Clapp *et al.* (“Clapp”) in view of United States Patent No. 6,484,515 to Hanco (“Hanco”) and in further view of United States Patent Application No. 2003/0084052 to Peterson (“Peterson”) when the combination of Clapp, Hanco, and Peterson fails to teach each and every element of the claimed invention and is improper because any such hypothetical combination would change the principle of operation of the references.

ARGUMENT

Ground of Rejection 1:

The preambles breathe life and meaning into the claims.

The Examiner has taken a new position in rejecting claims 1-20 in the Answer. For the first time in over six years of prosecution the Examiner has informed the Appellants that their reliance on elements of the preamble of the independent claims are now not being given any patentable weight, even though the Examiner has previously stated that the elements of the preamble are found in the combination of Clapp and Hanko.

At Page 9, the Answer states “it is noted that the features upon which Appellant relies (i.e., a ‘server that instructs the client’) are not recited in the rejected claim(s) ... the recitation of ‘a method of remotely controlling, by a server, the formation of an off-screen surface at a client’ has not been given patentable weight because their recitation occurs in the preamble. Again at Page 10, item 4, the Answer states the identical language.

Appellants agree that in certain circumstances that the preamble of the claim is not limiting. However, it is also noted that in some circumstance the preamble can provide patentability. Appellants contend this is an instance in which the preamble is of import and point the Examiner to M.P.E.P § 2110.02 from which Appellants recite below.

It is known that “[a] claim preamble has the import that the claim as a whole suggests for it.” *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). “If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is ‘necessary to give life, meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim.” *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). See also *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333, 68 USPQ2d 1154, 1158 (Fed. Cir. 2003).

Further, it is known that any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989). Further, it is a known proposition that "[c]lear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention." See *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d at 808-09, 62 USPQ2d at 1785 (emphasis added).

Appellants have repeatedly relied on the preamble during the prosecution of this application. In fact, the Examiner has even stated that the elements of the preamble are found in the relied upon references. It appears now that the Examiner is admitting that the elements of the claim are not found in the cited references. Instead of allowing the claims, the Examiner has stated a new ground of rejection by saying those elements that have been repeatedly argued by the Appellants should not be given patentable weight, because they are found in the preamble of the claim. Below is a summary of statements made by the Appellants and the response from the Examiner during the prosecution of the present application on this issue.

First Office Action 12-14-2004

The Examiner states at Page 4, that "Trower discloses the invention substantially as claimed include a method of remotely controlling, by a server, the formation of an off-screen surface at a client coupled to the server via communication network."

First Response - 3-14-2004

Appellants responded at Page 5, that "[i]ndependent claims 1 and 12 both require that the server instructs the client to select a first memory region for allocation to an off-screen surface, transmits indicia of a graphical data to the client, and instructs the client to copy the graphical data associated with the indicia to a particular location within the first memory region."

At Page 6, the Appellants stated that "Trower does not teach or suggest a server instructing a client to select a first memory region for allocation to an off-screen surface,

transmitting indicia of a graphical data to the client, and instructing the client to copy the graphical data associated with the indicia to a particular location within the first memory region, as required by independent claims 1 and 12.

Second Office Action - 6/13/2005.

The Examiner stated at Page 2, that "Clapp discloses the invention substantially as claimed including a method of remotely controlling, by a server, the formation of an off-screen surface at a client coupled to the server via a communications network, the method being performed at the server."

Second Reply - 10/13/2005

Appellants then responded and stated at Page 5, that "[i]ndependent claims 1 and 12 both require that the server instructs the client to select a first memory region for allocation to an off-screen surface, transmits indicia of a graphical data to the client, and instructs the client to copy the graphical data associated with the indicia to a particular location within the first memory region."

Further, at Page 6, Appellants stated that "[a]s shown and described in Clapp, the local host computer does not instruct the remote host computer to copy the off-screen buffer contents. Instead, the host computer performs the copying on its own. Therefore, Clapp does not teach a server that instructs the client to select a first memory region for allocation to an off-screen surface, and instructs the client to copy the graphical data associated with the indicia to a particular location within the first memory region."

Again, at Page 7, the Appellants argued that "Clapp fails to suggest a server that instructs a client to select a first memory region for allocation to an off-screen surface, and instructs the client to copy the graphical data associated with the indicia to a particular location within the first memory region."

Final Office Action - 1/27/06

In response, the Examiner again rejected the claims and stated at Page 2, in item 3, that

"Applicants' argued that (1) in Clapp, the local host computer does not instruct the remote host computer to copy the off-screen buffer contents."

Again, at item 6, at Page 3, the Examiner stated that "Applicants' argued that (3) Hanco does not teach a server instructs (sic) the client to copy the graphical data associated with the indicia to a particular location within the first memory region."

Pre-Appeal Brief Reasons for Requesting Review - April 20, 2006

Finally, Appellants maintained their position and at Page 2 stated "[n]owhere in Clapp, does a local computer instruct, as recited in Applicants' claimed invention, the remote computer to perform any function with the received off-screen window buffer data. This very point was argued to the Examiner in both of the previous responses.

Further, the local computer of Clapp does not instruct the remote computer to select a memory region for the remote computer's off-screen surface, as recited in Applicants' independent claims 1 and 12. In Clapp, there is no mention of such an instruction. That is, the local computer does not send an instruction to the remote computer to select a memory region to use as an off-screen surface. Again, the point was presented to the Examiner in both of the previous responses."

As shown above, Appellants have continuously argued that the "server instructs the client" and that argument has been accepted, analyzed, and refuted by the Examiner, that is until the Answer. Now, instead of addressing the fact that the cited references fail to disclose, teach, or suggest that which Appellants have claimed from their initial filing, the Examiner has found a new reason to reject the claims even though the Examiner has previously stated the points argued by the Appellants, (e.g., that the server instructs the client to establish an off-screen buffer), were found in the prior art.

For the reasons set forth above and those articulated in the Appeal Brief, Appellants respectfully request withdrawal of this rejection.

Ground of Rejection 2:

Claims 1, 2, 4-9, 12, and 14-18 are not obvious over Clapp in view of Hanko.

Claims 1, 2, 4-9, and 14-18 were rejected under 35 U.S.C. § 103 as being unpatentable over Clapp in view of Hanko. For the reasons set forth above with respect to Rejection 1 and those articulated in the Appeal Brief, Appellants respectfully request withdrawal of this rejection.

Ground of Rejection 3:

Claims 3, 10, 11, 13, 19, and 20 are not obvious over Clapp in view of Hanko and in further view of Peterson..

Claims 3, 10, 11, 13, 19, and 20 were rejected under 35 U.S.C. § 103 as being unpatentable over Clapp in view of Hanko and in further view of Peterson. For the reasons set forth above with respect to Rejection 1 and those articulated in the Appeal Brief, Appellants respectfully request withdrawal of this rejection.

CONCLUSION

Appellants again conclude with the belief that claims 1-20 are not obvious in light of the prior art. Allowance of the pending claims is respectfully requested.

Respectfully submitted,

Dated: October 15, 2007

/Leigh J. Martinson/

Leigh J. Martinson

Reg. No. 50,749

PATENT DEPARTMENT
CHOATE, HALL & STEWART LLP
Two International Place
Boston, Massachusetts 02110
Telephone: (617) 248-5000
Facsimile: (617) 248-4000